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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/637,600

08/11/2003

Michael Buchholz

232238US0X

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22850

7590

01/10/2007

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

SAYALA, CHHAYA D

ART UNIT

PAPER NUMBER

1761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

5

Office Action Summary

Application No.

10/637,600

Applicant(s)

BUCHHOLZ ET AL.

Examiner

C. SAYALA

Art Unit

1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 23-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/03, 1/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-11 and 23-25 in Paper mailed 10/13/2006 is acknowledged. The traversal is on the ground(s) that the examiner has not shown that applicant's animal additive can be made by prior art processes disclosed in applicant's specification. Also, applicant states that it is not clear that the claimed process can be used to make other amino acid feed supplements such as lysine because this has not been shown by the citation of any reference and it is only conjecture on the Examiner's part. This is not found persuasive because of the following reasons:

The MPEP directs that when inventions are related as process of making and product made, the inventions are distinct if **either** or both **of the following can be shown**: (1) that the process as claimed can be used to make other and materially different product **or** (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). The MPEP does not require a citation of any reference. It is presumed that the inventor has full knowledge of the prior art in the field of his endeavor (see rejection below). As for applicant's unsubstantiated statement that a search of all of the claims would not impose a serious burden on the examiner, it should be noted that the process claims recite limitations that are not contained in the product claims, and it is not clear if such a statement is a tacit implication that such limitations require no additional search.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, line 3, "a thiazolidine or together with L-cysteine, L-cystine, salts thereof and combinations thereof" appears to be incorrect, unless applicant intends L-cysteine, L-cystine, salts thereof and combinations thereof all to be present in this combination.

Claim 23 is indefinite in depending from non-elected claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 23-25 rejected under 35 U.S.C. 102(b) as being anticipated by Winterhalter et al. (US Patent 5972663).

The patent teaches a fermentative process that yields the compounds claimed

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See Tables 1-3 for amounts. The preamble "animal feed additive" is 'use' terminology and does not add any patentable weight. Besides, for composition claims, intended use of an otherwise old or obvious composition cannot render a claim patentable. In re Zierden, 162 USPQ 102, In re Jones, 50 USPQ 48, In re Spada, 15 USPQ 2d, 1655, In re Thuau 57 USPQ 324.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winterhalter et al. and Leinfelder et al. (US Patent 6218168) in view of Binder et al. (US Patent 5622710 and 6465025 and 5431933).

Both the primary patents teach the preparation of cysteine compounds in increased yields. The fermentation broth contains biotin, etc. and salts that contain cations that would yield salts of the amino acids. See for instance, col. 13, lines 49-50 in '663 and col. 5, lines 64-65 in '168. The references do not teach removing any part of the biomass or the application of the composition as a feed additive. However, prior art such as Binder et al. establish that it was known to use fermentation broth that comprised amino acids such as lysine, as animal feed additives. They also teach that

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the fermentation broth can be treated so as to contain all, none or part of the biomass. See the abstract in '710, col. 5, lines 5-10 and claim 9 in '025 and col. 7, lines 20-50, example 1, @ col. 8, lines 34-36 and example 4 @ lines 40-45 in '933. It would have been obvious to combine such aspects when the amino acids are cysteine compounds, because it was known in the art that sulfur containing compounds would have been useful as feed supplements, and to remove part or completely the biomass would also have been obvious since such an expedient was already shown and suggested by the Binder et al. patents. As for claims 10 and 11, animal feed additives in solid or liquid forms are shown by '710 and '025, and therefore, to formulate feed additives in a solid or liquid form would have been obvious from such teachings.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Nutrient Requirements of Dairy Cattle shows the importance of sulfur in the diet of cattle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



C. SAYALA
Primary Examiner
Group 1700.